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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,422	05/11/2001	Helmut Kinder	BARDP0115US	7683
7590	12/02/2003		EXAMINER	
RENNER, OTTO, BOISSELLE & SKLAR, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			DEBERADINIS, ROBERT L	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,422

Applicant(s)

KINDER, HELMUT

Examiner

Robert DeBeradinis

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,13,22,23 and 25 is/are rejected.
- 7) ☒ Claim(s) 3-6,8-12,14-21,24 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). g.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The response filed 5/22/03 consists of amendments to claims 1, 2, 4-7, 10-13, 15, 16, 18-23, an IDS and Remarks related to rejection of claims. The claims are not allowable for reasons given below.

An interview summary includes an interview with the Attorney wherein the claims discussed in the interview would be amended accordingly. The examiner did not enter an Examiner's Amendment to amend these claims because a new rejection was made.

Claim Rejections - 35 USC § 112

The multiple dependent claims 10, 13, 15, 18, 20 are objected to because they do not limit the dependent claim in accordance with what the applicant intended. The Applicant is expected to amend these claims.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2836

Claims 1, 2, 7, 22, 23, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by WOLF 3,956,727.

Regarding claims 1, 22

WOLF discloses a switching element for modifying the electric resistance comprising:

At least one high temperature superconductor (24);

Means for irradiating electromagnetic high frequency onto the at least one high temperature superconductor.

Regarding claims 2, 23.

WOLF teaches wherein the high temperature superconductor is a thin layer of a high temperature superconductor (24).

Regarding claims 7, 25.

WOLF teaches wherein the means irradiate the electromagnetic high frequency in the form of at least one pulse (column 1, lines 10-13).

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 13 is rejected under 35 U.S.C. 102(a) as being anticipated by VICTOR CO JP 2001332775.

Regarding claim 13.

VICTOR teaches magnetic energy storage comprising:

A magnetic coil for storing energy;

A switching element according to claim 1, wherein the switching of a switching element leads to a decoupling of the stored energy (figure 11).

Allowable Subject Matter

Claims 3-6, 8-12, 14-21, 24, 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Robert L. DeBeradinis whose number is (703) 306- 5857. The Examiner can normally be reached Monday-Friday from 8:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Sircus, can be reached on (703) 308-31190. The Fax phone number for this Group is (703) 308-7722.

RLD

NOVEMBER 24, 2003

